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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,135	06/07/2001	Kiju Ito	209630US2X	7668
22850	7590	04/21/2004		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER SOTOMAYOR, JOHN	
			ART UNIT 3714	PAPER NUMBER 13
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,135

Applicant(s)

ITO, KIJU

Examiner

John L Sotomayor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-28 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the amendment filed August 13, 2003 claims 1-6,8-22 and the newly added claims 23-28 are pending.

Specification

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

[Technological Arts Analysis]

For a claimed invention to be statutory, the claimed invention must be directed to a practical application within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-4,7 and 9-15 are clearly directed to a practical application within the technological arts by virtue of the use of a processor and storage in a memory device within the apparatus recited. Claims 5-6 and 16-21, however, are directed solely to the manipulation of abstract ideas involving no practical application within the technological arts.

[Useful, concrete and Tangible Analysis]

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. See, e.g., *State Street Bank and Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re*

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Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed Cir. 1994). See also *In re Schrader*, 22 F.3d 290, 297-98, 30 USPQ2d 1445, 1461-62 (Fed. Cir. 1994).

In the present case, claims 1-6 and 8-28 do not produce a concrete result. The claims recite a system, method, and program “for selecting factors contributing to enhance target people’s will to achieve results from a plurality of candidates of factors in a case where the calculated correlation coefficient is equal to or larger than a reference value.” One of ordinary skill in the art would not be able to arrive at a specific, repeatable end result for enhancing target people’s will to achieve results to any task as claimed without undue experimentation. This statement is evidenced by the subjective nature of attempts to change a target person’s will to achieve a result. Although numerical evaluation factors are chosen, as claimed, and used as a baseline against which to compare a target person’s responses to questions, the evaluation number itself is arrived at subjectively and may not represent any or all of the factors contributing to a successful results achievement on the part of the target person. See also the examiner’s undue experimentation analysis in the rejection set forth below under 35 U.S.C. 112 1st paragraph.

In addition, claims 8, 22, 27 and 28 are directed to a computer program per se used to execute method steps without the use of any computer readable medium. Computer programs not embodied in a tangible computer medium have been held to be non-statutory and, as such, claims 8, 22, 27 and 28 are rejected under 35 USC 101 as being directed to non-statutory subject matter.

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For the reasons set forth above, the invention set forth in claims 1-6 and 8-28 is not considered to be within any of the statutory classes of invention and therefore is not eligible for patent protection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it does not appear as if the invention could be practiced to produce a concrete result without undue experimentation. The factors set forth for a determination of undue experimentation are set forth in MPEP 2164.01(a), following the analysis in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In this case, the intended operation of the invention is to enhance a target person's will to achieve results. The factors used to determine whether the desired change in a target person's will has been achieved and the evaluation means for performing the determination are both subjective in nature (selecting an evaluation value numerically representing responses to sets of questions, etc.), with the result of the process being equally subjective. Applicant has not set forth any evidence that the reference value used as a baseline is a concrete value. Although the baseline number represents the set of

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answers to questions provided by individuals considered to be successful in achieving the work done that the target person is also engaged in, the fact remains that the baseline is compiled from individuals who are considered to be successful in the judgment of the evaluator. This may not represent the ideal of success for a target person, and for a group of target person's the evaluation criteria established may not be relevant to each individual's desire for success and such individual candidate factors cannot be determined without undue experimentation. In addition, Applicant has not set forth any evidence for determining that the factors for enhancing target people's will to achieve results are truly targeted by the invention, given the fact that the comparison criteria are derived subjectively, without undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 recites that the "questions are randomly to prevent artificial answers". This statement causes confusion about the claim as the Examiner cannot determine what random action will successfully prevent artificial answers and renders the claim indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonstetter et al (5,551,880) in view of Applicant Admitted Prior Art.

The applicant did not traverse the examiner's assertion that superior performance on a job is an indicator that an individual with superior work performance serves as a standard of measure against which other individuals may be compared and would provide information with which to perform a comparison. As there is no traversal the common and well-known in the art statement is taken to be applicant admitted prior art (AAPA).

Regarding claims 1 and 4, Bonstetter et al discloses a selection system comprising an output of questions to targeted users (Col 3, lines 29-35), a processor that receives responses to the questions (Col 3, lines 10-15), calculates a numerical value for the responses (Col 3, lines 15-28), discloses a selection system that generates valuation vectors based on the response to questions, generates a cluster of vectors showing similar tendencies to one another, and stores these vectors in memory (Col 5, lines 29-57), and compares the calculated coefficient to a standard reference value and uses this comparison to predict a personality trait that will achieve

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success (Col 3, lines 45-56). Bonstetter et al does not specifically disclose that input information represents work done by target individuals. However, Bonstetter teaches a standard measure for comparison is results of persons known to be superior performers for a job, or other selected standard (Col 4, lines 8-11). AAPA teaches that superior performance on a job is an indicator that an individual with superior work performance has accomplished all of the work required for a given work position and serves as a standard of measure against which other individuals may be compared and would provide information with which to perform a comparison. Therefore, it would have been obvious to one of ordinary skill in the art to provide a selection system comprising an output of questions to targeted users, a processor that receives responses to the questions, calculates a numerical value for the responses, and compares the calculated coefficient to a standard reference value as disclosed by Bonstetter and uses this comparison to predict a personality trait that will achieve success wherein input comparison information for correlation represents work done by target individuals as taught by AAPA for the purposes of selecting individuals who perform work at or above the level achieved by the baseline worker.

Regarding claim 2, Bonstetter et al discloses a selection system comprising a memory device in which the evaluation values for the question responses are stored (Col 5, lines 29-32).

Regarding claim 3, Bonstetter et al discloses a selection system that generates a plurality of evaluation values showing tendency to one another, an evaluation vector and that these values are stored in a storage device (Col 5, lines 29-48 and Lookup Table in Col 14).

Regarding claims 5 and 8, Bonstetter et al discloses a selection system comprising an output of questions to targeted users (Col 3, lines 29-35), a processor that receives responses to the questions (Col 3, lines 10-15), calculates a numerical value for the responses (Col 3, lines 15-

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28), and compares the calculated coefficient to a standard reference value and uses this comparison to predict a personality trait that will achieve success (Col 3, lines 45-56), and selecting the calculated coefficient where the calculated factor is equal to or greater than a standard reference value used to predict a personality trait that will achieve success (Col 4, lines 1-20 and Lookup Table in Col 14). Bonstetter et al does not specifically disclose that input information represents work done by target individuals. However, Bonstetter teaches a standard measure for comparison is results of persons known to be superior performers for a job, or other selected standard (Col 4, lines 8-11). AAPA teaches that superior performance on a job is an indicator that an individual with superior work performance has accomplished all of the work required for a given work position and serves as a standard of measure against which other individuals may be compared and would provide information with which to perform a comparison. Therefore, it would have been obvious to one of ordinary skill in the art to provide a selection system comprising an output of questions to targeted users, a processor that receives responses to the questions, calculates a numerical value for the responses, compares the calculated coefficient to a standard reference value, selecting the calculated coefficient where the calculated factor is equal to or greater than a standard reference value used to predict a personality trait that will achieve success as disclosed by Bonstetter, and uses this comparison to predict a personality trait that will achieve success wherein input comparison information for correlation represents work done by target individuals as taught by AAPA for the purposes of selecting individuals who perform work at or above the level achieved by the baseline worker.

Regarding claim 6, Bonstetter et al discloses a selection system that stores the calculated evaluation value corresponding to the responses to questions in memory (Col 5, lines 29-32).

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Regarding claim 9, Bonstetter et al discloses a processor for determining properties of each of the target people that are related to the selected factors based on an evaluation value numerically representing a response to each of the questions (Col 3, lines 18-28).

Regarding claims 10-12, Bonstetter et al discloses a determination system comprising reference data the includes a numerical evaluation value for question response (claim 10), a plurality of evaluation values combined to form an evaluation vector (claim 11), and a calculated factor related to a success oriented personality trait (claim 12) (Col 3, lines 18-28, Col 4, lines 8-20, and Lookup Table in Col 14).

Regarding claims 13 and 14, Bonstetter et al discloses a determination system in which the properties determined for target people are shown to the target people (claim 13) and an output device which displays the determined properties (claim 14) (Col 2, lines 30-34, and Lookup Table in Col 14).

Regarding claims 15 and 16, Bonstetter et al discloses a determination system comprising a computerized system for determining personality traits of target people which includes a memory device for storing reference data, a processor for determining properties of each of the target people that are related to the selected factors based on an evaluation value numerically representing a response to each of the questions based on stored reference data (Col 3, lines 40-56).

Regarding claim 17, Bonstetter et al discloses a method that comprises reference data that includes a numerical evaluation value for question response (Col 10).

Regarding claim 18, Bonstetter et al discloses a method in which related evaluation vectors numerically representing the responses to questions are stored in a cluster (Col 12).

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Regarding claim 19, Bonstetter et al discloses a method for referring responses to questions from a plurality of respondents in the same group and determining the properties of the group which are related to personality traits that contribute to success (Col 17, lines 35-67).

Regarding claim 20, Bonstetter et al discloses a method of showing an instruction created in accordance with determined personality traits to the target people (Col 2, lines 30-34).

Regarding claim 21, Bonstetter et al discloses a method that outputs the determined properties related to personality traits for respondents (Col 3, lines 65-67).

Regarding claim 22, Bonstetter et al discloses a program for determining properties related to selected factors, based on an evaluation value numerically representing the response to each of the questions posed of target people (Col 3, lines 18-28), and using the reference dated for determining the properties of the target people (Col 3, lines 37-55).

7. Claims 24,26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonstetter et al in view of Bro (US 5,722,418).

Regarding claims 24,26 and 28, Bonstetter et al discloses a selection system for selecting factors that contribute to a user's personality traits that will achieve success. Bonstetter et al does not specifically disclose that questions output to a user are randomly output. However, Bro teaches a method of contacting individuals for the purposes of mediating behavioral processes that include outputting questions in a random manner for particular individuals (Col 8, line 65 – Col 9, line 3). Therefore, it would have been obvious to one of ordinary skill in the art to provide a selection system for selecting factors that contribute to a user's personality traits that will achieve success as disclosed by Bonstetter et al with random questions output to the user as

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taught by Bro for the purposes of reinforcing desired behavior and discouraging artificial behaviors.

Response to Arguments

Applicant's arguments filed 2/3/2004 have been fully considered but they are not persuasive. The applicant argues that the prior art of record does not disclose or suggest selecting will-enhancement-factors from candidates of factors. However, Bonstetter et al discloses the selection of factors that induce a user to aspire to better job performance and, thus, a will to achieve success in a critical aspect of the user's livelihood. The process of the selection of factors recited in applicant's system is the same as the process disclosed by Bonstetter et al. The means recited by the applicant and disclosed by Bonstetter et al both allow for outputting questions to targeted users, a processor that receives responses to said questions, calculation of a numerical response, generation of value vectors, and selecting and comparing a calculated coefficient to standard reference value. The selected factors represent superior job performance and directly relate to a user's will to achieve superior performance. The selected factors are chosen from a set of candidates of factors that are determined beforehand. However, the purpose, increasing a user's will to achieve success, is the same as the purpose recited in the instant application. Thus the system and method recited in the instant application is not patentably distinct over the cited prior art and the argument is not persuasive.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Merrill et al (5,954,510) for a discussion of an interactive goal-achievement system and method.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Sotomayor whose telephone number is 703-305-4558. The examiner can normally be reached on 6:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jls
April 7, 2004



JESSICA HARRISON
PRIMARY EXAMINER